

REMARKS

Claims 1-5 are pending in this application. By this Amendment, claim 1 is amended.

No new matter is added.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Ometz in the December 7, 2004 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

The Office Action objects to the disclosure because the continuing data is considered incorrect by not reflecting the abandoned status of parent Application No. 09/970,786.

However, it is respectfully submitted that no change to the disclosure is required because the holding of abandonment in parent Application No. 09/970,786 should be withdrawn, for the reasons set forth in the Petition to Withdraw Holding of Abandonment filed September 2, 2004 in the parent application (copy attached).

Claims 1, 2 and 5 stand rejected under 35 U.S.C. §102(e) over U.S. Patent Application Publication No. 2001/0019467 to Otsuka et al. (hereafter, "Otsuka"). This rejection is respectfully traversed.

Independent claim 1 recites *inter alia* a slider in which "the first surface of the substrate is located farther from the recording medium than the surface of the insulating portion that constitutes the part of the medium facing surface when the medium facing surface is parallel to the recording medium." It is respectfully submitted that Otsuka fails to disclose, teach or suggest these claimed features.

Otsuka discloses a slider S having a slider body 10 (substrate) having a first surface, adjacent adhesive layer 61, that faces toward the recording medium 71 and a second surface, adjacent magnetic gap G. See Fig. 2 of Otsuka. An insulating portion surrounding a magnetic head element is adjacent the second surface (i.e., to the left of magnetic gap G in Fig. 2). The insulating portion has a surface that faces toward the recording medium 71, and

thus arguably constitutes part of the medium facing surface. As identified by the Office Action, a medium facing layer 64 has a surface that constitutes another part of the medium facing surface.

As discussed during the personal interview, Fig. 2 of Otsuka shows the slider S tilted relative to the recording medium 71. When the medium facing surface of the slider S is parallel to the recording medium 71, the first surface of the substrate 10 (i.e., the surface adjacent and parallel to the adhesive layer 61) is located closer to the recording medium 71 than the surface of the insulating portion that faces toward the recording medium 71 (i.e., the surface adjacent to the magnetic gap G and parallel to the adhesive layer 61). This is contrary to claim 1 which recites that "the first surface of the substrate is located farther from the recording medium than the surface of the insulating portion that constitutes the part of the medium facing surface when the medium facing surface is parallel to the recording medium."

As agreed at the personal interview, claim 1 would be patentably distinguishable over Otsuka if amended to include language to avoid interpreting Otsuka in its tilted condition, in addition to the proposed claim language. Amended claim 1 includes such language.

Therefore, it is respectfully submitted that claim 1 is patentable over Otsuka. Further, it is respectfully submitted that claims 2 and 5 are patentable over Otsuka at least in view of the patentability of claim 1 from which they depend, as well as for the additional features they recite. Accordingly, withdrawal of the rejection of claims 1, 2 and 5 over Otsuka is respectfully requested.

Claims 1, 2 and 5 stand rejected under 35 U.S.C. §103(a) over Japanese Application Publication No. 9-63027 (hereafter, "Shigeru") in view of U.S. Patent No. 6,404,592 to Saito et al. (hereafter, "Saito"). This rejection is respectfully traversed.

Independent claim 1 recites *inter alia* a slider in which "the medium facing layer does not cover the surface of the insulating portion that constitutes the part of the medium facing

surface." It is respectfully submitted that neither Shigeru nor Saito, either alone or in combination, discloses, teaches or suggests these claimed features.

The Abstract of Shigeru discloses a magnetic head/slider in which "DLC films 34 having the smooth surfaces are uniformly formed on the ABS surfaces 24." The DLC films 34 are identified by the Office Action as a medium facing layer. However, as shown in Fig. (b), the DLC films 34 cover the entire length of the magnetic head, including the surface of protective film portion 28 (surrounding the magnetic head elements 30) that faces the recording medium. This is contrary to claim 1 which recites that "the medium facing layer does not cover the surface of the insulating portion that constitutes the part of the medium facing surface."

Saito does not make up for this deficiency of Shigeru. As shown in Fig. 1B, Saito similarly discloses that the carbon film 10 (medium facing layer) covers the entire length of the magnetic head, including the surface of protective layer 8 (surrounding the thin film element 3) that faces the recording medium.

As agreed at the personal interview, it is respectfully submitted that claim 1 is patentable over Shigeru and Saito. Further, it is respectfully submitted that claims 2 and 5 are patentable over Shigeru and Saito at least in view of the patentability of claim 1 from which they depend, as well as for the additional features they recite. Accordingly, withdrawal of the rejection of claims 1, 2 and 5 over Shigeru and Saito is respectfully requested.

Claims 3 and 4 stand rejected under 35 U.S.C. §103(a) over Shigeru in view of Saito, and further in view of U.S. Patent Application Publication No. 2001/0030835 to Hipwell et al. (hereafter, "Hipwell"). This rejection is respectfully traversed.

As discussed above, Shigeru and Saito fail to disclose, teach or suggest each and every feature recited in claim 1 from which claims 3 and 4 depend. Hipwell does not make up for the deficiencies of Shigeru and Saito.

Therefore, as agreed at the personal interview, it is respectfully submitted that claims 3 and 4 are patentable over Shigeru, Saito and Hipwell at least in view of the patentability of claim 1 from which they depend, as well as for the additional features they recite. Accordingly, withdrawal of the rejection of claims 3 and 4 over Shigeru, Saito and Hipwell is respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-5 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Klifton L. Kime
Registration No. 42,733

JAO:KLK/kzb

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OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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